



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re application of
Lyons, Karen et al.
Serial No. 10/693,845
Filed: October 20, 2003

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: DECISION ON
: PETITION

For: PLATINUM-IMPREGNATED HYDROUS TIN OXIDE CATALYSTS

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed May 23, 2007.

On October 6, 2006, a non-final office action was mailed to applicant rejecting claim 3 under 35 USC 112, second paragraph, claims 1, 2, 4, 10-12, 17 and 18 under 35 USC 102 over Watanabe et al., claims 1, 2, 4, 5, 12, 13, 15, and 17 under 35 USC 102 over Gardner et al., claims 1-4 under 35 USC 102 over Katayama, and claims 1, 2, and 4-16 under 35 USC 103 over Watanabe in view of Watanabe et al.. A reply to the office action was filed by Applicant on January 5, 2007. In the reply, Applicant amended claim 3 to incorporate language proposed in the non-final office action for overcoming the 35 USC 112, second paragraph rejection. A final office action was mailed by the office on March 23, 2007 in which the rejection of claims 1-4 under 35 USC 102 over Katayama was withdrawn and two new grounds of rejection were set forth over claim 3 under 35 USC 103, Watanabe et al. in view of Katayama and Gardner et al. in view of Katayama.

On May 22, 2007, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the March 23, 2007 office action, along with a response to the final rejection.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

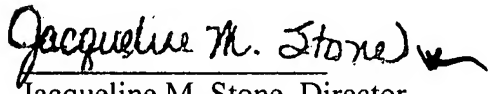
706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that the amendments made to claim 3 were of a trivial nature, the effect of which was only for values near 30% and that the new grounds of rejection cite only references cited in the prior non-final office action, therefore, the new grounds of rejection were not necessitated by Applicant's amendments to the claims. This argument is persuasive. The new grounds of rejection over claim 3 were clearly not necessitated by Applicant's amendment because the small change, if any, in the weight percentage range in claim 3 as amended did not necessitate withdrawing the rejection of claims 1-4 under 35 USC 102 over Katayama and making the new grounds of rejection of claim 3 under 35 USC 103 over Watanabe et al. in view of Katayama and Gardner et al. in view of Katayama.

Because the rejection of claim 3 based on a new ground of rejection was improper, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response continues to run from March 23, 2007. Extensions of time may be obtained to file any amendments.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S. W.
WASHINGTON, DC 20375-5320